

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 16, 2005. At the time of the Office Action, Claims 1-17 were pending in this Application. Claims 18-20 were previously cancelled due to an election/restriction requirement. Claims 1-8 and 11-14 were rejected and Claims 9, 10 and 15-17 were objected to as being dependent upon a rejected base claim. Claims 1-17 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1-5, 7, 8 and 13 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,311,950 issued to Andreas Kappel et al. ("Kappel et al."). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Independent Claim 1 recites, among other limitations, an actuator fixed to an injector housing by “caulking *between* the top plate and the injector housing.” Similarly, Independent Claim 18 recites a method including the step of providing caulking *between* the top plate and the injector housing.

The Examiner cites Kappel as anticipating Independent Claims 1 and 18. Applicants note, however, that Kappel teaches the use of a laser weld 20 for securing a bearing plate 11 to housing 1. As is clearly shown in Figures 1 and 4, Kappel discloses providing bearing plate 11 adjacent to housing 1 and providing a weld 20 on a *top* portion of the bearing plate 11 and the housing 1. Accordingly, Kappel provides no disclosure, teaching or suggestion of caulking *between* a top plate and an injector housing, as claimed.

Accordingly, Applicants respectfully submit that Kappel cannot anticipate Independent Claims 1 and 18 because Kappel fails to disclose, teach or suggest each and every claimed limitation. Applicants request reconsideration, withdrawal of the §102 rejections and full allowance of Claims 1 and 18 and Claims 2-5, 7 and 8 which depend therefrom.

Rejections under 35 U.S.C. § 103

Claims 6, 11, 12 and 14 were rejected by the Examiner under 35 U.S.C. 35 U.S.C. §103(a) as being unpatentable over Kappel. Applicants respectfully traverse.

In order to make Applicants’ claimed invention obvious, the cited references must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). For at least the reasons discussed above, Applicants submit that Kappel cannot render Claims 6, 11, 12 and 14 obvious, as these claims depend from an Independent Claim now placed in condition for allowance. Applicants request reconsideration, withdrawal of the §103 rejections and full allowance of Claims 6, 11, 12 and 14.

Information Disclosure Statement

Applicants would like to bring to the Examiner's attention that Applicants filed an Information Disclosure Statement on February 17, 2004. Applicants respectfully request that the Information Disclosure Statements be considered and cited in the examination of the above-referenced application. Applicants attach a copy of the Information Disclosure Statement and PTO Form 1449 filed February 17, 2004 for the Examiner's convenience and a copy of the postcard receipt evidencing receipt by the Patent Office.

Allowable Subject Matter

Applicants appreciate the Examiner's consideration and indication that Claims 9, 10 and 15-17 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Applicants thank the Examiner for the timely and favorable consideration of these claims.

Applicants submit that amended Claims 9 and 10 now include limitations previously recited in Claims 1 and 8. Amended Claim 15 now includes the limitations of previously recited Claim 1.

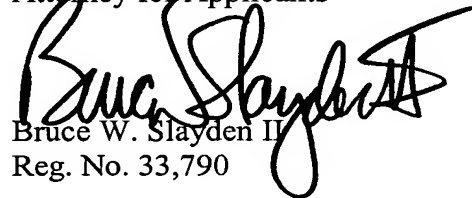
CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of Claims 1-17 as amended.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2606.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants


Bruce W. Slayden II
Reg. No. 33,790

SEND CORRESPONDENCE TO:
BAKER BOTTS L.L.P.
CUSTOMER ACCOUNT NO. **31625**
512.322.2606
512.322.8306 (fax)

Date: 6/15/2005